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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,320	04/03/2001	Gary Liu	10664-147001	4156

26181 7590 10/22/2003

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REDWOOD CITY, CA 94063

EXAMINER
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ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/826,320

Applicant(s)

Gary Liu

Examiner  
Pierre E. Elisca

Art Unit  
3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04/03/2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

**Serial Number: 09/826,320**

**Page 2**

**Art Unit: 3621**



**Examiner Pierre Eddy Elisca**  
**United States Department of Commerce**  
**Patent and Trademark Office**  
**Washington, D.C. 20231**

**DETAILED ACTION**

1. This Office action is in response to Application No. 09/826,320, filed on 04/03/2001.
2. Claims 1-9 are pending.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-9 are rejected under 35 U.S.C. 102(2) as being anticipated by Al-Salqan (U.S. pat. No. 6,549,626).

**Art Unit: 3621**

As per claims 1, and 4-9 Al-Salqan discloses a key such as a private key or key password of a private key is encrypted for storage, and may be decrypted if the private key becomes lost or unavailable. The key is encrypted by encoding, for example, by using hashing, private information, and the result is used as a key to encrypted the private key DES, comprising:

encrypted a message using a symmetric key (see., abstract, col 2, lines 49-64, col 1, lines 29-38, specifically wherein it is stated that a message transmitted from sender to recipient may be symmetrically encrypted);

sending the encrypted message to an intended recipient without the symmetric key (see., abstract, col 2, lines 49-64, col 1, lines 29-38, specifically asymmetric encryption or private/public keys);

providing the symmetric key to a third party (see., col 1, lines 51-67, specifically wherein it is stated that a trusted party known as a certificate authority issues a certificate which allows third parties to verify the identity of the principal, please note that principal or private/public keys or symmetric key or DES); and

if the intended recipient signs and returns to the third party a receipt (or certificate) for the message, transferring, by the third party, the receipt to the sender and providing the symmetric key to the intended recipient (see., abstract, col 1, lines 29-38, and lines 51-67, specifically wherein it is stated that a trusted party known as a certificate authority issues a certificate which allows third parties to verify the identity of the principal, please note that principal or private/public keys or symmetric key or DES, and abstract, specifically wherein said to decrypt the key recovery file, the private key corresponding to the public key used to encrypt the key recovery filed is used to decrypt the key

**Art Unit: 3621**

recovery file. The result is symmetrically decrypted using a key obtained by encoding).

As per claim 2, Al-Salqan discloses the claimed method wherein the receipt signed by the recipient contains an identifier computed from the message and the symmetric key using cryptographically secure hash functions (see., col 1, lines 50-67, col 4, lines 47-67).

As per claim 3, Al-Salqan discloses a key such as a private key or key password of a private key is encrypted for storage, and may be decrypted if the private key becomes lost or unavailable. The key is encrypted by encoding, for example, by using hashing, private information, and the result is used as a key to encrypted the private key DES, comprising:

at the sender, encrypted a message using a symmetric key, encrypting the symmetric key to make the symmetric key accessible to a third party but not to a recipient and sending the encrypted message and the encrypted symmetric key to an intended recipient (see., abstract, col 2, lines 49-64, col 1, lines 29-38, specifically wherein it is stated that a message transmitted from sender to recipient may be symmetrically encrypted);

at the recipient, signing a receipt for the message and sending the receipt and the encrypted symmetric key to the third party (see., abstract, col 2, lines 49-64, col 1, lines 29-38, specifically asymmetric encryption or private/public keys);

at the third party, transferring the receipt to the sender and providing the symmetric key to the intended recipient if the receipt (or certificate) is properly signed (see., col 1, lines 51-67, specifically wherein it is stated that a trusted party known as a certificate authority issues a certificate which

**Art Unit: 3621**

allows third parties to verify the identity of the principal, please note that principal or private/public keys or symmetric key or DES, see., abstract, col 1, lines 29-38, and lines 51-67, specifically wherein it is stated that a trusted party known as a certificate authority issues a certificate which allows third parties to verify the identity of the principal, please note that principal or private/public keys or symmetric key or DES, and abstract, specifically wherein said to decrypt the key recovery file, the private key corresponding to the public key used to encrypt the key recovery file is used to decrypt the key recovery file. The result is symmetrically decrypted using a key obtained by encoding).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claim 11 is rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

Claims 1-8 are directed to a non-statutory subject matter. Specifically the claims are directed towards an abstract idea. There is no computer performing any step. Therefore, Applicant is advised to embed a computer or processor or module into claims 1-8 in order to overcome this 101 rejection. Appropriate correction is required.

***Conclusion***

7. Any inquiry concerning this communication from the examiner should be directed to Pierre

**Serial Number: 09/826,320**

**Page 6**

**Art Unit: 3621**

Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.


**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

**(703) 305-7687**

  
Pierre Eddy Elisca

Patent Examiner

**October 14, 2003**